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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,930	09/11/2003	Wayne E. Cornish	ACS 65357 (1512XCC)	5064

7590

05/04/2006

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EXAMINER
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ROY, ANURADHA

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/659,930

**Applicant(s)**

CORNISH ET AL.

**Examiner**

Anuradha Roy

**Art Unit**

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 64-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 71-84 is/are allowed.
- 6) ☒ Claim(s) 64-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/15/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 64-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Sahatjian et al. (US Patent No. 5,283,004).

Regarding claim 64, Sahatjian et al. discloses an intracorporeal device comprising an elongated member (12) having means for causing a substantially linear change in stiffness over a longitudinal length of the elongated member (Column 4, lines 11-44 & Figure 4A).

In regards to claim 65, Sahatjian et al. discloses a device, where in the length of the elongated member has a continuously changing taper angle (Figure 1) producing a curvilinear profile that is configured to produce the substantially linear change in stiffness over said length (Figure 4A).

With regard to claim 66, Sahatjian et al. discloses a device, wherein the elongated member has a plurality of tapered segments (16 to 18) configured to produce the substantially linear change in stiffness over the length of the member.

Regarding claim 67, Sahatjian et al. discloses a device, wherein each tapered segment has a substantially constant taper angle.

With regard to claim 68, Sahatjian et al. discloses a device, wherein the elongate core member comprises at least 3 to about 100 tapered segments (16 to 18).

In regards to claim 69, Sahatjian et al. discloses a device, wherein the elongated core member comprises a material with changing hardness in a longitudinal direction configured such that the change in hardness produces a substantially linear change in stiffness along the length of the core member (Figure 4A & Column 4, lines 11-23).

Regarding claim 70, Sahatjian et al. discloses a device wherein the elongated member tapers distally to a more flexible distal portion (Column 5, lines 36-40).

#### **Allowable Subject Matter**

Claims 71-84 are allowed under the terminal disclaimer filed by the Applicant on December 15, 2005 and approved by the office on December 29, 2005.

#### ***Response to Arguments***

Applicant's arguments with respect to claim 64-70 have been considered but are moot in view of the new ground(s) of rejection. Regarding the earliest filing date the current application, the Examiner has reviewed the abandoned parent application (08/868,764 filed 6/04/1997) and has determined that the earliest filing date the current application would receive is December, 1, 1998 for the following reasons: "an elongated member having a means for causing a substantially linear change in stiffness over a longitudinal length of the elongated member," as well as the formulas claimed in claims 71 & 78 are not disclosed within the abandoned parent application.

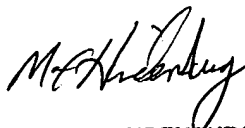
### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anuradha Roy whose telephone number is (571) 272-6169 and whose email address is [anuradha.roy@uspto.gov](mailto:anuradha.roy@uspto.gov). The examiner can normally be reached between 8:00am and 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~AR~

  
MAX F. HINDENBURG  
PATENT EXAMINER  
10/10/2007